

**REMARKS**

Claims 1-67 are currently pending and are presently under consideration. Independent claims 1, 15, 24, 30, 32, 40, 42, 44, 46, 51 and 59 have been amended herein to further emphasize novel aspects of the subject invention. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1-11, 24, 25, 27-36, 38-49, 51-57 and 59-66 Under 35 U.S.C §102(a)**

Claims 1-11, 24, 25, 27-36, 38-49, 51-57 and 59-66 stand rejected under 35 U.S.C §102(a) as being anticipated by Ellis *et al.* (WO 00/04709). Applicants' representative respectfully requests that this rejection be withdrawn for at least the following reasons. Ellis *et al.* fails to disclose all limitations of the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The claimed invention relates to a system for providing program criteria to facilitate recording of a specific audio and/or visual program. In particular, independent claims 1, 15, 24, 30, 32, 40, 42, 44, 46, 51 and 59 recite similar aspects, namely a server computer storing a plurality of tokens, each token having a system unique identifier for identifying a predetermined at least one of an audio and visual program, *the at least one of an audio and visual program formed of at least two program segments, the at least two program segments each associated with a disparate token.* Ellis *et al.* is silent regarding such features of the claimed invention.

Ellis *et al.* relates to a system that allows a user of a remote computer to effectuate changes to local interactive television program guide equipment by submitting a request to a programming guide server. The server processes the request and updates the local interactive television program guide equipment. This provides the user the capability of setting user

preferences such as parental controls, recording, *etc.* However, nowhere does the cited reference partition portions of an audio or visual program into multiple segments each with associated token identifiers. Thus, for example, the cited reference does not allow for dynamically inserting desired program segments (*e.g.* commercials based on viewing characteristics of the client system) between adjacent pairs of program segments of a corresponding program to provide customized advertisements during playback of the corresponding program. The claimed invention, on the other hand, allows for such customization by assigning a token identifier to at least two segments that form an audio or visual program.

In view of at least the foregoing, it is readily apparent that Ellis *et al.* does not teach the identical invention in as much detail as is contained in the subject claims. Accordingly, this rejection should be withdrawn.

## **II. Rejection of Claims 15-21, 50, 58 and 67 Under 35 U.S.C §103(a)**

Claims 15-21, 50, 58 and 67 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis *et al.* Withdrawal of this rejection is requested for at least the following reasons. The subject claims either directly or indirectly recite *the at least one of an audio and visual program formed of at least two program segments, the at least two program segments each associated with a disparate token*, and as previously discussed, Ellis *et al.* fails to teach or suggest such features of the subject claims. Thus, this rejection should be withdrawn.

## **III. Rejection of Claims 12-14, 22-23, 26 and 37 Under 35 U.S.C §103(a)**

Claims 12-14, 22-23, 26 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis *et al.*, in view of Knudson *et al.* (US 6,536,041). Applicants' representative respectfully requests that this rejection be withdrawn for at least the following reasons. The subject claims depend from independent claims 1, 15, 24 and 32, and as noted above, Ellis *et al.* does not disclose all aspects of claims 1, 15, 24 and 32; and Knudson *et al.* does not compensate for the deficiencies of the primary reference. Accordingly, withdrawal of this rejection is requested.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP131US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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